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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,813	08/21/2003	Akihisa Matsuno	M619 0001	6171

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OYEN, WIGGS, GREEN & MUTALA LLP
480 - THE STATION
601 WEST CORDOVA STREET
VANCOUVER, BC V6B 1G1
CANADA

EXAMINER

MOHANDESI, JILA M

ART UNIT PAPER NUMBER

3728

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/644,813

Applicant(s)

MATSUNO, AKIHISA

Examiner

Jila M Mohandesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 17, 18, 25-27, 32-34 and 38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 19-24, 28-31 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-19-03, 02-03-05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species directed to a container as follows:

Species I directed to a container as shown in Figures 2-3.

Species II directed to a container as shown in Figures 10-15.

Species III directed to a container as shown in Figure 21.

Species directed to an apparatus as follows:

Species A directed to an apparatus as shown in Figure 7.

Species B directed to an apparatus as shown in Figure 4.

Species directed to a pivot joint as follows:

Species a directed to a pivot joint as shown in Figure 18.

Species b directed to a pivot joint as shown in Figure 19.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include

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all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with applicant's attorney Mr. Rattray on March 16, 2005 a provisional election was made without traverse to prosecute the invention of Species II of the container, species A of the apparatus and species b of the pivot joint, claims 1-16, 19-24 and 35-37. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-18, 25-34 and 38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1-4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finn (2,922,527) in view of Ku (6,644,482). Finn '527 discloses a container for housing optical discs, the container comprising: a base (56); a lid (56) coupled to the base by a pivot joint for releasably housing an optical disc between the base and the lid, the pivot joint permitting pivotal motion of the lid relative to the base about a pivot axis that is substantially orthogonal to a plane of the disc housed between the base and the lid; and a hanging fastener (integral aperture ear 58) for coupling the container to a rod. Finn '527 does not appear to teach the hanging fastener to be in the form of a hook. Ku '482 discloses that it is desirable to form the hanging fastener as a hanging hook with a finger for easier hanging and removal of the container on a rod or rope. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the hanging fastener of Finn '527 as a hook as taught by Ku '482 for easier hanging and removal of the container from the rod.

5. Claims 5-7, 9-15, 19-22, 28-29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claims 1-2 above, and further in view of Paloheimo (5,848,688). Finn '527 modified above discloses all the limitations of the claims except for the specifics of the pivot joint. Paloheimo '688 discloses a pivot joint define at least a portion of an inwardly extending channel which leads towards the pivot joint and terminates in a bore located within the pivot joint. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the pivot joint with a channel and bore as taught by Paloheimo '688 for a tighter pivot joint connection.

With respect to claim 26, note the notch (9) and flange (8) locking mechanism as shown in Figure 3 embodiment.

With respect to claim 27 and the locking mechanism, whether the closure means is a notch and flange or any other art recognized equivalent is an obvious matter of choice, such as to require less manual dexterity to operate.

With respect to the shape of the channel, bore, finger and the container base and lid, Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify these shapes since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

6. Claims 16, 23-24 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above references as applied to claim 1 above, and further in view of Ho (6,648,135). Finn '527 modified above discloses all the limitations of the claims except for a retainer for releasably holding the optical disc against a surface thereof and a latch mechanism. Ho '135 discloses that it is desirable to provide a deformable retainer for releasable holding the optical disc against a surface thereof. Ho' 135 also discloses a latch mechanism for maintaining the lid in a closed pivotal orientation with respect to the base. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a deformable retainer to the container of Finn '527 as taught by Ho '135 to better hold the disc therein. Also it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a

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latch mechanism to the container of Finn '527 as taught by Ho '135 for maintaining the lid in a closed pivotal orientation with respect to the base.

Conclusion

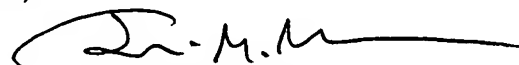
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Shown are containers analogous to applicant's instant invention.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jila M Mohandesi whose telephone number is (571) 272-4558. The examiner can normally be reached on Monday-Friday 7:30-4:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**JILA M. MOHANDESI
PRIMARY EXAMINER**



Jila M Mohandesi
Primary Examiner
Art Unit 3728

JMM
April 01, 2005

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